

REMARKS

Claims Rejections - 35 USC §102(b)

Claims 1-6 and 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,918,391 issued to Viñas Peya. The applicant has carefully reviewed the '391 reference and respectfully disagrees with the Office. The applicant thanks the Office for its diligence and thoughtful response. The applicant notes that the Office acknowledges that the cited reference fails to disclose those elements discussed by the Applicant in Applicant's Response of July 11, 2008. The applicant has cancelled claim 1, in favor of new claim 16, containing the substance of claim 1, and including a clarification of the structure of the "appendix", amended to "fin" as used in the specification, and the "slit". The applicant respectfully submits that this clarifies the claim language's articulation of these elements, and does not add new matter.

A rejection based on anticipation requires that a single reference teach every element of the claim (MPEP § 2131). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Or stated in another way, a "claim is anticipated only if each and every element as set forth in the claim is found, . . . described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). . .

To overcome the anticipation rejection, the Applicant needs to only demonstrate that not all elements of a prima facie case of anticipation have been met, i.e., show that the prior art reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent." In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

The applicant respectfully draws the Office's attention to claim 16:

Claim 16 (New): A tooth for a bucket, said tooth comprising:

- A work element;
- A support element, said support element having a main body whereby said support element is able to be fixed to said bucket and a front protrusion;
- A mating cavity disposed within said work element and configured to receive said front protrusion in a coupling condition;
- A pin configured to secure said working element and said support element in said coupling condition;
- A fin protruding from a rear of said work element and configured to be received by a mating recess disposed in said main body of said support element, said fin being **disposed between first and second shoulders** of said working element and having an **upper profile disposed at an angle to said first shoulder and within said mating recess when said tooth is in said coupling condition**;
- A first slit **disposed between said upper profile of said fin and an upper surface of said mating recess**;
- A housing seating disposed at least partially in said fin and said main body and configured to received said pin.

The applicant respectfully submits that the cited '391 reference fails to disclose a slit disposed between an upper edge of a mating recess and an upper profile of said fin. The applicant respectfully submits that the "slit", alleged by the Office to be disclosed by the '391 reference is, on the contrary, not disposed between the upper edge of the mating recess and the upper profile of the fin.

The Office's allegation relates to the following figure, reproduced from the Office Action to which this is a response.

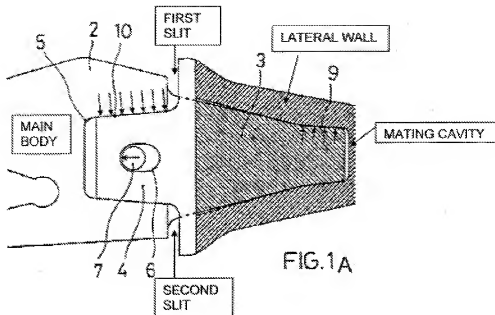
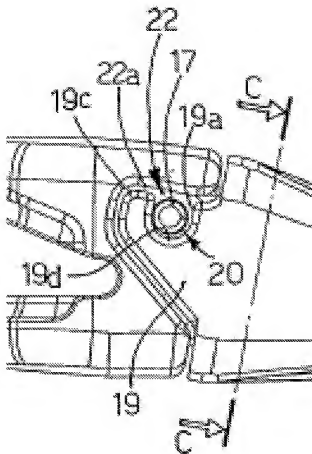


FIG. 1A

The applicant respectfully disagrees with the Office's interpretation of claim 1 and Fig. 1 A of the cited reference. The applicant has however amended the claims to clarify the claimed invention, and believes that this adequately distinguishes the claim from the cited reference. The applicant respectfully submits that substituted claim 16, in particular, clarifies the location and structure of the slit. The resulting structure has the separation between the fin and the mating recess that is discussed at length in the previous office action. The applicant respectfully submits that the benefits of such an arrangement are likewise articulated at length in the previous response, and need not be repeated here.



Detail of Fig. 3 of the claimed invention

The Applicant respectfully submits that the cited reference fails to disclose the claimed configuration. As noted in the previous Response, the applicant notes that rather than direct the forces of excavation to the front protrusion as in the claimed invention, the cited reference directs pressure on the rearward projection, an undesirable result according to the claimed invention.

At least for these reasons, the Applicant respectfully submits that the cited '391 reference fails to disclose the claimed invention of claim 1. As claims 2-6, 8-13 are dependant from claim 16, the applicant respectfully submits that these claims are likewise distinguished from the cited '391

reference. The Applicant therefore respectfully requests that the Office withdraw its rejection of these claims.

Claim Rejections – 35 USC § 103

Claims 7, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '391 reference in view of other references. The Office's rejection of claim 7 is made on the basis of the '391 reference alone, while that of claims 14 and 15 is made on the basis of the '391 reference in combination with US Patent No. 4,338,736 issued to Radigan.

Applicant has carefully considered the Office rejections and respectfully submits that the amended claims, as supported by the arguments herein, are distinguishable from the cited references, either alone or in combination.

According to the MPEP §2143.01, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art."

A useful presentation for the proper standard for determining obviousness under 35 USC §103(a) can be illustrated as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue;
3. Resolving the level of ordinary skill in the pertinent art; and
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

The applicant notes that claims 7, 14 and 15 are, either directly or indirectly, dependant from new independent claim 16, and the cited references fail to address those aspects of that claim discussed in length above.

The applicant respectfully submits that at least for those reasons recited above, claims 7, 14, and 15 are patentably distinct from the cited reference, either alone or in combination. The applicant therefore respectfully requests that the Office withdraw its rejection of these claims.

Applicant believes the above amendments and remarks to be fully responsive to the Office Action, thereby placing this application in condition for allowance. No new matter is added. Applicant requests speedy reconsideration, and further requests that Examiner contact its attorney by telephone, facsimile, or email for quickest resolution, if there are any remaining issues.

Respectfully submitted,

/Andrew P. Cernota, Reg. No.52,711/

Cus. No. 24222
Vern Maine & Associates
PO Box 3445
Nashua, NH 03061-3445
Tel. No. (603) 886-6100, Fax. No. (603) 886-4796
patents@vernmaine.com

Vernon C. Maine, Reg. No. 37,389
Andrew P. Cernota, Reg. No. 52,711
David A. Rardin, Reg. No. 52,153
Attorneys/Agents for Applicant